



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/637,608
Applicant : FLYNN ET AL.
Filed : AUGUST 11, 2003
Title : HYDROGEN ODORANTS AND ODORANT SELECTION METHOD

Art Unit : 1754
Examiner : LANGEL, WAYNE A.

Atty Docket No. : ENER-0001-UT1

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In conjunction with the Notice of Appeal concurrently filed for the above application involving Claims 2-4, 7-11, 47-53 and 59 on appeal, Applicants respectfully request a pre-appeal brief review under Official Gazette Notice of July 12, 2005 which authorizes Pre-Appeal Brief Conferences.

I. Basis for Request for Review.

This request is necessitated by the following deficiencies in the Final Action of December 20, 2005 (Final Action): (1) failure of the Examiner to comply with 37 CFR § 104(d)(2) in providing an affidavit/declaration requested by the Applicants in their October 27, 2005 Amendment (Applicants' October 2005 Amendment); (2) maintaining rejections against Claims 2-4, 7-11, 47-53 and 59 based on reasoning that contradicts the conclusions reached in the July 24, 2004 Restriction Requirement (Restriction Requirement); (3) failure to comply with 37 CFR § 104(c)(2) in fully specifying the basis for rejecting Claims 2-4, 7-11, 47-53 and 59; (4) failure to comply with MPEP § 706.02(j) in providing a proper "motivation to combine" the references relied on to reject Claims 2-4, 7-11, 47-53 and 59; (5) impermissible hindsight reliance on Applicants' own disclosure in rejecting Claims 2-4, 7-11, 47-53 and 59; (6) applying an improper "obvious to try" standard in rejecting Claims 2-4, 7-11, 47-53 and 59; (7) maintaining rejections against Claims 2-4, 7-11, 47-53 and 59 based on reasoning that contradicts the conclusions reached in the Final Action's Non-Elected Invention Determination; and (8) rejecting Claim 59 based on reasoning that is contrary to scientific fact.

A. Failure to Comply with 37 CFR § 104(d)(2).

In the Office Action of July 27, 2005 (July Office Action), the Examiner made several statements having no basis in the references relied on in rejecting Claims 2-4, 7-11, 47-53 and 59;. In their response to the July Office Action, (see Applicants' October 2005 Amendment, Section E, pp. 29-30), Applicants properly requested the Examiner to supply an affidavit/declaration under 37 CFR § 1.104(d)(2) in support of those statements. Because the Examiner has failed to comply with the 37 CFR § 1.104(d)(2) in providing the requested affidavit/declaration, the rejections of Claims 2-4, 7-11, 47-53 and 59 are *prima facie* improper and should be withdrawn, with Claims 2-4, 7-11, 47-53 and 59 being deemed in condition for allowance.

B. Rejections that Are Based on Reasoning that Directly Contradicts the Conclusions of the Restriction Requirement.

French Patent No. 2,645,622 (FR '622) only describes the use of *sulfur-containing compounds* such as mercaptans, thiophanes, and TBM (tertiary butyl mercaptan) as an odorous product (see FR '622 Abstract and Applicants' Amendment, Section A(2)(a), pp. 10-12; Section B(2)(a), pp. 17-18; Section C(2)(a), pp. 22-23; and Section D(2)(a), pp. 27-28). As admitted at page 4 of his July 24, 2004 Restriction Requirement (Restriction Requirement), selenium compounds, methylamine or trimethylamine, oxygen compounds and nitrogen compounds are *patentably distinct* species from these sulfur compounds taught by FR '622. In view of the conclusions reached in the Restriction Requirement, a reference, such as FR '622, that only describes using sulfur compounds as odorants cannot teach or suggest using selenium compounds, methylamine or trimethylamine, oxygen compounds or nitrogen compounds as odorants, much less the use of *any odorous gaseous product* as an odorant. Instead, and in direct contradiction to the conclusions reached in Restriction Requirement, the Final Action maintains that "FR '622 suggests in the Abstract that *any odorous gaseous product* may be added" (emphasis added) in rejecting: Claims 2-4, 7-11, 47-53 and 59 over FR '622 in view of: U.S. Patent No. 1,643,954 to Prentice (Prentice) (see Final Action p. 3); Claims 2, 7-11 and 59 over FR '622 in view of U.S. Patent No. 5,221,545 to Borschel *et al.* (Borschel) or U.S. Patent No. 4,496,639 to Rasmussen *et al.* (Rasmussen) (see Final Action. p. 3); Claims 2, 3, 7-11, 47-49, 52 and 59 over FR '622 in view of U.S. Published Application No. 2002-0197304 to Schrauzer (Schrauzer) (see Final Action, pp. 3-4); and Claims 2, 4, 7-11, 50, 51, 53 and 59 over FR '622 in view of U.S. Patent No. 4,656,038 to Baugh (Baugh) (see Final Action, p. 4). Accordingly, Claims 2-4, 7-11, 47-53 and 59 have been rejected based on reasoning that directly contradicts the conclusions reached in the Restriction Requirement, and, therefore, the rejections of Claims 2-4, 7-11, 47-53 and 59 are *prima facie* improper for at least this additional reason and should be withdrawn.

C. Failure to Comply with 37 CFR § 104(c)(2).

In rejecting: Claims 2-4, 7-11, 47-53 and 59 over FR '622 in view Prentice; Claims 2, 7-11 and 59 over FR '622 in view Borschel or Rasmussen; Claims 2, 3, 7-11, 47-49, 52 and 59 over FR '622 in view of Schrauzer; and Claims 2, 4, 7-11, 50, 51, 53 and 59 over FR '622 in view of Baugh, the Final Action alleges that "FR '622 suggests in the Abstract that any odorous gaseous product may be added" (see citations to the Final Action in Section B above). But, the Final Action never identifies where FR '622 describes the use of single odorous product that does not contain sulfur. Instead, FR '622 only discloses sulfur compounds. Therefore, for the above reasons, the Final Action fails to comply with 37 CFR § 1.104(c)(2) that requires the "pertinence . . .

of each reference be *clearly explained* (emphasis added).” Because the Final Action fails to comply with 37 CFR § 1.104(c)(2) for at least the reasons discussed above, the rejections of Claims 2-4, 7-11, 47-53 and 59 are *prima facie* improper and should be withdrawn.

D. Failure to Articulate a Proper Basis for “Motivation to Combine” References.

Nowhere does the Final Action (see Final Action, pp. 5-6) provide a proper basis for combining the teachings of the references relied on in rejecting Claims 2-4, 7-11, 47-53 and 59. The Final Action’s basis for combining each of Prentice, Borschel, Rasmussen, Schrauzer and Baugh with FR ‘622 relies solely on the conclusory statement that “FR ‘622 suggests in the Abstract that any odorous gaseous product may be added” (see citations to the Final Action in Section B above). The Final Action also makes the following allegation:

Applicants’ argument, that FR ‘622 does not and cannot suggest compounds other than sulfur compounds may be used as odorants with hydrogen is not convincing, since applicants have not explained why the disclosure in the Abstract of FR ‘622 of adding an “odorous gaseous product” would not suggest the addition of an odorous gaseous product, regardless of whether such product is sulfur-containing or non-sulfur containing (see Final Action, p. 4)

However, the Abstract of FR ‘622 does not state that “any odorous gaseous product may be added.” In fact, what the Abstract of FR ‘622 states is that “an odorous product is added, *such as a mercaptan, a thiophane, or a product known under the name ‘TBM’*” (see FR ‘622 Abstract, emphasis added). As pointed out in Applicants’ Amendment, mercaptans, thiophanes and TBM (tertiary butyl mercaptan) are all *sulfur-containing compounds* (see Applicants’ Amendment, Section A(2)(a), pp. 10-12; Section B(2)(a), pp. 17-18; Section C(2)(a), pp. 22-23; and Section D(2)(a), pp. 27-28). Furthermore, in view of the conclusions reached in the Restriction Requirement, a reference such as FR ‘622 that only describes sulfur-containing compounds cannot teach or suggest that a person of ordinary skill in the art may look for a reference describing a selenium compound, including the Prentice, Borschel, Rasmussen, Schrauzer and Baugh references. Accordingly, each of the combinations of Prentice, Borschel, Rasmussen, Schrauzer and Baugh with FR ‘622 fail to comply with MPEP § 706.02(j) that requires that “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art*, to modify the reference or to combine reference teachings (emphasis added)” Therefore, for at least the reasons discussed above, the rejections of Claims 2-4, 7-11, 47-53 and 59 based on the above combinations of references are *prima facie* improper and should be withdrawn.

E. Impermissible Hindsight Reliance on Applicants’ Own Disclosure.

The combining in the Final Action of references describing selenium compounds, such as Prentice, Borschel, Rasmussen, Schrauzer and Baugh, with FR ‘622 that neither teaches nor suggests selenium compounds, must be presumed to be based on improper hindsight reliance on Applicants’ own disclosure in the present application. This follows from: (1) the failure of the Final Action to identify a single non-sulfur compound taught or suggested by FR ‘622 with (2) the Restriction Requirement conclusively stating that selenium compounds are *patentably distinct* from sulfur compounds (see discussion in Sections B, C and D above). As the Federal Circuit has stated in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.* 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that “Prior knowledge in the field of the invention must be supported by tangible teachings

of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Accordingly, given that selenium compounds are *patentably distinct* from sulfur compounds, a person of ordinary skill in the art reading FR '622, which only teaches sulfur compounds, would have not motivation to look for references describing non-sulfur (*e.g.*, selenium) compounds, but for improperly reading Applicants' own disclosure. Therefore, for this additional reason, the rejections of Claims 2-4, 7-11, 47-53 and 59 based on the above combinations of references are *prima facie* improper and should be withdrawn.

F. Impermissible Obvious to Try Standard Used to Reject Claims.

The Final Action has not identified any criteria in FR '622 or Prentice that would enable a person of ordinary skill in the art to choose which of the several odorants described in Prentice could be used in the place of the mercaptan, thiophane and TBM odorants of FR '622 in a composition including hydrogen. Therefore, the Final Action appears to argue that it would be merely "obvious to try" to substitute a selenide of Prentice for the sulfur compounds of FR '622. As stated in *In re Deuel*, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995), "'Obvious to try' has long been held not to constitute obviousness. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988)." The rejection of Claims 2-4, 7-11, 47-53 and 59 over FR '622 in view of Prentice thus relies on improper an "obvious to try" standard. Therefore, the rejection of Claims 2-4, 7-11, 47-53 and 59 over FR '622 in view of Prentice is *prima facie* improper, and should be withdrawn.

G. Rejections that Are Based on Reasoning that Contradicts the Conclusions Reached in the Non-Elected Invention Determination of the Final Action.

In the Final Action, newly submitted Claims 54-58, 60 and 61 were held in the Non-Elected Invention Determination Section of the Final Action to be directed to a non-elected invention (see Final Action, p. 2). This means that Claims 54-58, 60 and 61 are considered to be *patentably distinct* from Claims 2-4, 7-11, 45-53 and 59. Applicants note that allowable elected Claims 45 and 46 claim "A fuel cell containing the composition of claim 2" and "The fuel cell of Claim 45 wherein the fuel cell is a vehicle fuel cell," respectively. Furthermore, Applicants note that Claim 57 claims a container containing the composition of Claim 2, "wherein said container is part of a vehicle." Given that the Final Action has held that a vehicle including a container containing the composition of Claim 2 is *patentably distinct* from a vehicle including a fuel cell containing the composition of Claim 2, the Non-Elected Invention Determination Section in the Final Action effectively states that even a slight difference in the use of an odorous composition may be patentable distinction over a different use of the same odorous composition. But the Final Action instead alleges that person of ordinary skill in the art reading the Abstract describing a method for dispensing industrial hydrogen (FR '622, see Abstract) would be motivated to look for a reference describing: a defensive and offensive projector composition (see Prentice, Title and p.1, lines 1-3); a method of providing selenium in a nutritional product (see Borschel, Title and Col. 1, lines 7-10); a hydrogen selenide treatment of electrolytes (see Rasmussen, Title, and Col. 1, lines 31-38); compositions for the treatment of cancer (see Schrauzer, Title and paragraph [0010]; and an animal repellent (see Baugh, Title and Col. 2, lines 55-62) (see Final Action, pp. 3-4). As can be seen, in rejecting Claims 2-4, 7-11, 47-53 and 59, the Final Action combines references that are far more dissimilar from each other than the product of Claim 57 is from that of Claim 46. Accordingly, Claims 2-4, 7-11, 47-53 and 59 have been rejected

based on reasoning that contradicts the Non-Elected Invention Determination in the Final Action, and, therefore, the rejections of Claims 2-4, 7-11, 47-53 and 59 are *prima facie* improper for this additional reason.

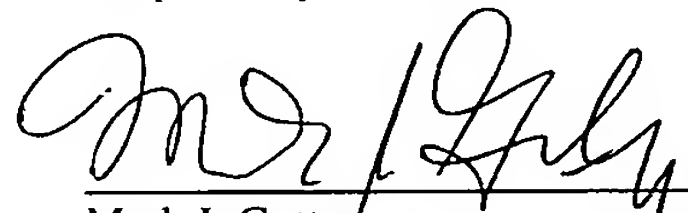
H. Claim 59 has been Rejected Based on Reasoning that is Contrary to Scientific Fact.

In rejecting Claim 59 under 35 U.S.C. § 112, first paragraph, the Final Action alleges that the specification states that “the odorant is in a vapor phase at detectable concentration at a pressure of 6000 psi, which is not the same as being the vapor phase at a pressure greater than atmospheric pressure” (see Final Action, p. 2). Applicants note that 6000 psi is considerably above atmospheric pressure which is well-known to be around 14.7 psi. Accordingly, Claim 59 has been improperly rejected based on reasoning that is contrary to scientific fact, and, therefore, the rejection of Claim 59 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

II. Relief Requested.

For at least the reasons discussed above, all of the rejections of Claims 2-4, 7-11, 47-53 and 59 in the Final Action are *prima facie* improper and should be withdrawn. Therefore, Applicants hereby request that all of the rejections be withdrawn and Claims 2-4, 7-11, 47-53 and 59 be allowed.

Respectfully submitted,


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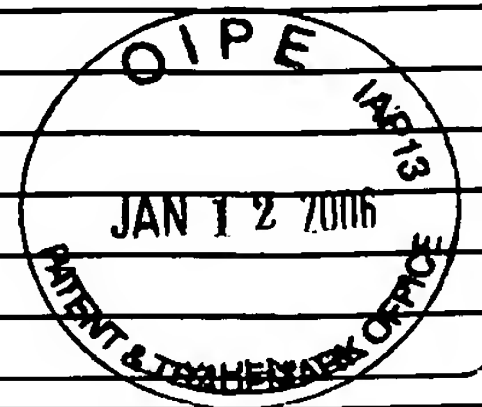
Patent Fee Transmittal for FY 2005

☐ Applicant Claims Small Entity Status 37 C.F.R. 1.27

TOTAL AMOUNT OF PAYMENT

\$0.00

Application Number 10/637,608
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Named Inventor FLYNN, et al.
Examiner Name LANGE, Wayne A.
Art Unit 1754
Attorney Docket No. ENER-0001-UT1



FEE CALCULATION

1. Filing Fees

Application Type	Description	Large Entity		Small Entity		Paid
		Code	(\$)	Code	(\$)	
Utility	Basic	1011	300	2011	150	\$ -
	Examination	1311	200	2311	100	\$ -
	Search	1111	500	2111	250	\$ -
Design	Basic	1012	200	2012	100	\$ -
	Examination	1312	130	2312	65	\$ -
	Search	1112	100	2112	50	\$ -
Plant	Basic	1013	200	2013	100	\$ -
	Examination	1313	160	2313	80	\$ -
	Search	1113	300	2113	150	\$ -
Reissue	Basic	1014	300	2014	150	\$ -
	Examination	1114	600	2114	300	\$ -
	Search	1314	500	2314	250	\$ -
Provisional	Basic	1005	200	2005	100	\$ -
National Stage	Basic	1631	300	2631	150	\$ -
	Examination	1633	200	2633	100	\$ -
	Search	1632	500	2632	250	\$ -

2. Extra Claim Fee

a. Claims as Filed

		Large Entity		Small Entity		Paid
		Code	(\$)	Code	(\$)	
Total Claims	0 - 20 = 0	1201	50	2201	25	\$ -
Independent	0 - 3 = 0	1202	200	2202	100	\$ -
Multiple Dependent		1203	360	2203	180	\$ -

b. Claims as Amended

		Large Entity		Small Entity		Paid
		Code	(\$)	Code	(\$)	
Total Claims	43 - 44 * = 0	1201	50	2201	25	\$ -
Independent	1 - 3 ** = 0	1202	200	2202	100	\$ -
First Presentation of Multiple Dependent		1203	360	2203	180	\$ -

* Less than 20, enter 20 ** Less than 3, enter 3

3. Extra Page Fee

		Large Entity		Small Entity		Paid
		Code	(\$)	Code	(\$)	
Total Pages	0 - 100	1081	250	2081	125	\$ -

Subtotal for Application Fees

1 \$ - + 2 \$ - + 3 \$ - = \$ -

4. Additional Fees

Description	Large Entity		Small Entity		Paid	Description (cont.)	Large Entity		Small Entity		Paid
	Code	(\$)	Code	(\$)			Code	(\$)	Code	(\$)	
Extension for response first month	1251	120	2251	60	\$ -	Recording each Assignment	8021	40	8021	40	\$ -
Extension for response second month	1252	450	2252	225	\$ -	Submission of IDS	1806	180	1806	180	\$ -
Extension for response third month	1253	1,020	2253	510	\$ -	Request for Cont. Examination (RCE)	1801	790	2801	395	\$ -
Extension for response fourth month	1254	1,590	2254	795	\$ -	Filing Submission After Final	1809	790	2809	395	\$ -
Extension for response fifth month	1255	2,160	2255	1,080	\$ -	Surcharge - late filing fee or oath	1051	130	2051	65	\$ -
Notice of Appeal	1401	500	2401	250	\$ -	Surcharge - late provisional fee	1052	50	2052	25	\$ -
Filing a Brief in Support of an Appeal	1402	500	2402	250	\$ -	Non-English Specification	1053	130	1053	130	\$ -
Request for Oral hearing	1403	1,000	2403	500	\$ -	Processing Fee 37 CFR 1.17(q)	1807	50	1807	50	\$ -
Petitions under 1.17(f)	1462	400	1462	400	\$ -	Request for Ex Parte Reexamination	1812	2,520	1812	2,520	\$ -
Petitions under 1.17(g)	1463	200	1463	200	\$ -	Request Pub. of SIR prior to action	1804	920	1804	920	\$ -
Petitions under 1.17(h)	1464	130	1464	130	\$ -	Request Pub. of SIR after action	1805	1,840	1805	1,840	\$ -
Petition - public use proceeding	1451	1,510	1451	1,510	\$ -	Each Add. Invention Examined	1810	790	2810	395	\$ -
Petition to Revive - Unavoidable	1452	500	2452	250	\$ -	Expedited Examination (Design)	1802	900	1802	900	\$ -
Petition to Revive - Unintentional	1453	1,500	2453	750	\$ -	Unintentionally Delayed Priority Claim	1453	1,370	1453	1,370	\$ -
Utility Issue Fee	1501	1,400	2501	700	\$ -	Certificate of Correction	1811	100	1811	100	\$ -
Design Issue Fee	1502	800	2502	400	\$ -	Maintenance Fees 3.5 years	1551	900	2551	450	\$ -
Plant Issue Fee	1503	1,100	2503	550	\$ -	Maintenance Fees 7.5 years	1552	2,300	2552	1,150	\$ -
Reissue Issue Fee	1511	1,400	2511	700	\$ -	Maintenance Fees 11.5 years	1553	3,800	2553	1,900	\$ -
Publication Fee	1504	300	1504	300	\$ -	Surcharge - Late Payment 6 mos.	1554	130	2554	65	\$ -
Statutory Disclaimer	1814	130	2814	65	\$ -	Other fee					\$ -

(cont.)

Additional Fee Subtotal

\$ -

METHOD OF PAYMENT (Check all that apply)

☐ Credit Card (Provide credit card information and authorization on PTO-2038)

☒ Deposit Account No.

10-0233-ENER-0001-UT1

For the above-identified deposit account, the Director is hereby authorized to:

☐ To charge the above-identified fee.

☒ To charge any additional fees which may be required under 37 CFR 1.16, 1.17, 1.18, 1.20 and 1.492 or credit any overpayment to the deposit account number listed above.

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